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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/777,745

02/12/2004

Gregory A. Griffin

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30409

7590

08/22/2006

EXAMINER

PATEL, VISHAL A

INTERNATIONAL ENGINE INTELLECTUAL PROPERTY COMPANY

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WARRENVILLE, IL 60555

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,745

Applicant(s)

GRIFFIN ET AL.

Examiner

Vishal Patel

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 and 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Unclear how a gasket can have a fastener, since a gasket assembly can have a fastener but not a gasket. Attention should be given to what applicant has originally claimed just a gasket.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schenk (US. 6,553,664) in view of Farnam (US. 3,811,689) and further in view of Fucci et al (US. 4,819,954).

Schenk discloses a gasket having a metal substrate (substrate having 18a-18b) disposed along an outer perimeter of the gasket, an elastomeric bead (bead having 68, see figure 8) disposed along at least a part of an interior of the metal substrate, the metal substrate having a fastener openings (plurality of openings 60) having an inner diameter (inner diameter of 60), a fastener capable of being disposed in the openings (as stated in the reference that 60 are bolt

Art Unit: 3673

holes that will receive fasteners), fasteners having an outer diameter (outer diameter of a potential fastener), a plurality of teeth (teeth that are shown in figure 1) disposed along an outer perimeter of the elastomeric bead correspond with a plurality of grooves (grooves on inner perimeter as shown in figure 2) disposed along at least a section of the interior perimeter of the metal substrate, the elastomeric bead is also placed on an outer perimeter of the gasket in a manner same as the elastomeric bead placed on the inner perimeter of the gasket (figures 8-9 and column 6) and the gasket is capable of fitting a flange having a fastener hole (this would be the case since the gasket of Schenk is capable of being used between two flange surfaces). The gasket is capable of being used in a manner as claimed by applicant in claims 6-7, 10-11. The gasket having a depression in the metal substrate (depression having a sealing bead).

Schenk discloses the invention substantially as claimed above but fails to disclose that each of the fastener openings having an elastomeric ring. Farnam teaches that a gasket having fastener openings and each fastener opening having an elastomeric ring on an inner diameter of the fastener opening (see figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure each of the fastener opening of Schenk to have an elastomeric ring as taught by Farnam to provide a seal around fasteners when the fasteners are installed through the elastomeric rings (column 2, lines 30-36 or lines 45-56).

Schenk and Farnam disclose the invention substantially as claimed above but fail to disclose that an inner diameter of the elastomeric ring being smaller than an outer diameter of the fastener. Fucci et al discloses an elastomeric ring or plastic ring around a fastener opening in a gasket, the elastomeric ring having an inner diameter smaller than an outer diameter of the fastener (see figure 4). It would have been obvious to one having ordinary skill in the art at the

Art Unit: 3673

time the invention was made to have the inner diameter of Schenk and Farnam to be smaller than an outer diameter of the fastener as taught by Fucci, to provide a subassembly by the fastener components (column 3, lines 60-66 of Fucci).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belter (US. 5,618,047) in view of Farnam and in further view of Fucci.

Belter discloses a gasket having a metal substrate disposed along an outer perimeter of the gasket, an elastomeric bead disposed along an interior perimeter of the metal substrate and a plurality of teeth (44) disposed along an outer perimeter of the elastomeric bead corresponding with a plurality of groove (figure 6) disposed along at least a section of the interior perimeter of the metal substrate. A fastener receivable in openings 48. The openings having an inner diameter.

With regard to the ring having the inner diameter smaller than an outer diameter of a fastener. Applicant has not positively claimed the fastener and therefore the limitation is not given patentable weight.

The limitation that the elastomer is injection molded is not given patentable weight because this is a process limitation within a product claim. The gasket comprising a depression formed in the metal substrate (depression having 42 or wavy depression having 42).

Belter discloses substantially the same seal as applicant except for an elastomeric ring disposed along fastener holes on the metal substrate. Farnam discloses an elastomeric ring (24) disposed along fastener holes (holes in sheet gasket that holds a fastener) that hold fastener along a substrate in order to provide sealing around a fastener. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Belter gasket to have an elastomeric ring that has fastener as taught by Farnam in order to provide sealing around a fastener and retain a fastener before attachment of the gasket to a member (column 2, lines 30-36 or lines 45-56). Furthermore Farnam also teaches to select a material for the bushing by a matter of environmental use (depends on compression force or thermal load or etc).

Belter and Farnam disclose the invention substantially as claimed above but fail to disclose that an inner diameter of the elastomeric ring being smaller than an outer diameter of the fastener. Fucci et al discloses an elastomeric ring or plastic ring around a fastener opening in a gasket, the elastomeric ring having an inner diameter smaller than an outer diameter of the fastener (see figure 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the inner diameter of Belter and Farnam to be smaller than an outer diameter of the fastener as taught by Fucci, to provide a subassembly by the fastener components (column 3, lines 60-66 of Fucci).

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schenk, Farnam and Fucci as applied to claims above, and further in view of Inciong (Us. 6,543,787).

Schenk, Farnam and Fucci disclose the invention substantially as claimed above but fail to disclose that the elastomeric bead and the elastomeric are form as a continuous rubber material. Inciong discloses that a gasket having an elastomeric ring and an elastomeric bead

Art Unit: 3673

disposed around a metal substrate to be formed as a continuous member (see figures). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the elastomeric ring and the elastomeric bead of Schenk, Farnam and Fucci to be formed as a single piece as taught by Inciong to reduce cost (this would be the case since both the elastomeric bead and the elastomeric ring would be formed in a single molding process).

8. Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Belter, Farnam and Fucci as applied to claims above, and further in view of Nenzell (US. 2,795,444).

Belter, Farnam and Fucci disclose the invention substantially as claimed above but fail to disclose that the first and second elastomeric rings on fastener openings are connected to the inner diameter of the fastener openings by plurality of teeth placed in plurality of grooves formed on the inner diameter of the fastener openings. Nenzell discloses a fastener opening in a substrate and a rubber member attached to an inner diameter of the opening by plurality of teeth received in grooves in the inner diameter of the opening (see figures 1-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the inner diameter of the fastener openings and the elastomeric rings of Belter, Farnam and Fucci to have grooves and teethes, respectively as taught by Nenzell, to provide a proper connection or strong connection between the inner diameter of the fastener openings and the elastomeric rings (see column 3, lines 1-6 of Nenzell).

9. Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schenk, Farnam and Fucci as applied to claims above, and further in view of Nenzell (US. 2,795,444).

Schenk, Farnam and Fucci disclose the invention substantially as claimed above but fail to disclose that the first and second elastomeric rings on fastener openings are connected to the

Art Unit: 3673

inner diameter of the fastener openings by plurality of teeth placed in plurality of grooves formed on the inner diameter of the fastener openings. Nenzell discloses a fastener opening in a substrate and a rubber member attached to an inner diameter of the opening by plurality of teeth received in grooves in the inner diameter of the opening (see figures 1-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the inner diameter of the fastener openings and the elastomeric rings of Schenk, Farnam and Fucci to have grooves and teethes, respectively as taught by Nenzell, to provide a proper connection or strong connection between the inner diameter of the fastener openings and the elastomeric rings (see column 3, lines 1-6 of Nenzell).

Response to Arguments

10. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3673

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP
August 20, 2006

A handwritten signature in black ink, appearing to read "Vishal Patel", with a stylized flourish at the end.

Vishal Patel
Primary Examiner
Tech. Center 3600